

## **REMARKS**

### **I. Status of the Claims**

Claims 1-45 are present in the application. Of those claims, claims 13-16, 18, 19, 21-36, 39, 40, 42, and 43 have been withdrawn from further consideration in this application as being directed to non-elected subject matter. Thus, claims 1-12, 17, 20, 37, 38, 41, 44, and 45 are present in the application and pending on the merits.

By this Response, claims 1 and 44 have been amended to recite "a composition comprising calcined kaolin, . . . wherein the calcined kaolin [(or as recited in claim 44, "the composition")] has a median particle size ranging from at least 1.0 to about 3  $\mu\text{m}$ ," while claim 37 has been amended to recite a "composition comprising fully calcined kaolin . . . ." Support for these amendments may be found, for example, in paragraph [022] and Tables I and II of the originally-filed disclosure.

In the Office Action, claims 44 and 45 were rejected under 35 U.S.C. § 102(b) based on U.S. Patent No. 5,393,340 to Slepetyts et al. ("Slepetyts").<sup>1</sup> Office Action at 2. Claims 1-12, 17, 20, 37, 38, and 41 were rejected under 35 U.S.C. § 103(a) based on Slepetyts in view of U.S. Patent No. 6,312,511 B1 to Bilimoria et al. ("Bilimoria"). Id. at 3-4.

Claims 1, 37, 41, and 44 are the only independent claims pending in the application. Concerning the rejections of independent claims 1, 37, and 44, Applicant has amended those claims and respectfully submits that those claims comply with 35 U.S.C. §§ 102(b) and 103(a) for at least the reasons outlined in more detail herein. Nevertheless, to the extent that the Examiner considers rejecting those claims based on

the references of record in the application, Applicant respectfully submits that independent claims 1, 37, and 44 are patentably distinguishable from those references, and such claim rejections would be improper for at least the reasons outlined herein. With respect to the rejection of remaining independent claim 41, Applicant respectfully traverses the § 103(a) rejection of that claim based on Slepetys in view of Bilimoria for at least the reasons outlined in more detail herein.

## **II. Claim Rejection under 35 U.S.C. § 102(b) Based on Slepetys**

With respect to the § 102(b) rejection of independent claim 44 based on Slepetys, Applicant respectfully submits that Slepetys does not disclose, expressly or inherently, all of the subject matter recited in amended independent claim 44. Thus, Applicant respectfully requests reconsideration and withdrawal of the claim rejection.

According to The Manual of Patent Examining Procedure ("M.P.E.P."), "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." § 2131 (citation omitted). Moreover, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claim." Id. (citation omitted).

The rejection statement refers to Table VI of Slepetys as disclosing the subject matter recited in independent claim 44. Office Action at 2. Applicant respectfully submits that the cited portion of Slepetys does not supply any disclosure related to "a median particle size ranging from at least 1.0  $\mu\text{m}$  to about 3  $\mu\text{m}$ ," as recited in amended independent claim 44. For at least this reason, Slepetys fails to expressly or inherently

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<sup>1</sup> Applicant respectfully submits that the Office Action contains assertions concerning the related art and the claims. Regardless of whether those assertions are addressed specifically herein, Applicant respectfully declines to automatically subscribe to them.

disclose all of the subject matter recited in independent claim 44 or claim 45, which depends from claim 44, of the present application. Thus, the rejection of those claims under 35 U.S.C. § 102(b) based on Slepetys should be withdrawn.

### III. Claim Rejection under 35 U.S.C. § 103(a)

Turning now to the rejection of claims 1-12, 17, 20, 37, 38, and 41 under 35 U.S.C. § 103(a) based on Slepetys in combination with Bilimoria, Applicant respectfully submits that the rejection statement's hypothetical combination of Slepetys and Bilimoria fails to disclose or render *prima facie* obvious all of the subject matter recited in claims 1-12, 17, 20, 37, 38, and 41.

#### **A. Rejection of Independent Claims 1 and 41**

By this Response, Applicant has amended independent claim 1 to recite "a composition comprising calcined kaolin, . . . wherein the calcined kaolin has a median particle size ranging from at least 1.0 to about 3  $\mu\text{m}$  . . . ." The rejection statement's hypothetical combination of Slepetys and Bilimoria fails to disclose or render obvious at least this subject matter recited in amended independent claim 1. More specifically, for at least the reasons outlined previously herein with respect to the § 102(b) rejection of claim 44, Slepetys does not supply any disclosure related to "a median particle size ranging from at least 1.0  $\mu\text{m}$  to about 3  $\mu\text{m}$ ," and Bilimoria does not remedy the deficient teaching of Slepetys. Consequently, the subject matter recited in claim 1 cannot be achieved by the hypothetical combination of Slepetys and Bilimoria. For at least this reason, Slepetys and Bilimoria, regardless of whether they are viewed individually or as

a whole, fail to disclose or render *prima facie* obvious all of the subject matter recited in independent claim 1.

In addition to the above-outlined reason, Applicant's independent claims 1 and 41 are not *prima facie* obvious based on the rejection statement's hypothetical combination of Slepetys and Bilimoria because the rejection statement fails to properly set forth a *prima facie* case of obviousness.

According to the M.P.E.P., "[t]he key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious," and further, "rejections on obviousness cannot be sustained with mere conclusory statements." M.P.E.P. § 2142 (internal citation and inner quotation omitted). Moreover, "[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art." Id. at § 2143.01(III). In addition, "[i]n determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious." Id. at § 2141.02(I).

"[T]he framework for objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 U.S.P.Q 459 (1966) . . . . The factual inquiries . . . [include determining the scope and contents of the prior art and] . . . [a]scertaining the differences between the claimed invention and the prior art." Id. at § 2141(II). The M.P.E.P. advises that once the factual inquiries have been made, "Office personnel must explain why the difference(s) between the prior art

and the claimed invention would have been obvious to one of ordinary skill in the art.”

Id. at § 2141(III).

The rejection statement concedes that Slepetys fails to disclose “limit[ing] the amount of alkali and alkaline earth metal to less than about 1.0%.” Office Action at 3. In an effort to remedy the deficient teachings of Slepetys, the rejection statement asserts that “[a]s there is no recitation of removing alkali and alkaline earth from the Rio Capim clays, the evidence of record suggests that such clays naturally include less than about 1.0% alkali and alkaline earth metals.”<sup>2</sup> Id. at 3-4.

Here, a *prima facie* case for obviousness has not been established at least because the scope and content of Bilimoria has not been properly determined, and consequently, the rejection statement has not recognized the differences between Applicant’s claims and the prior art. As noted above, the rejection statement relies on the evidence of record for purportedly suggesting that Rio Capim “clays naturally include less than about 1.0% alkali and alkaline earth metals.” Id. Applicant respectfully disagrees.

Despite Bilimoria containing no disclosure or suggestion of the alkali and alkaline earth metal content of kaolin, whether obtained from the Rio Capim region or any other geographic area, the rejection statement appears to rely on this lack of disclosure as purportedly teaching a kaolin having “a total of alkali and alkaline earth metals present in the composition . . . less than or equal to about 1.0% by weight, relative to the total

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<sup>2</sup> Since the rejection statement indicates that Bilimoria is the secondary reference for the rejection under 35 U.S.C. § 103(a), Applicant addresses this rejection as if the rejection statement is referring to Bilimoria as the purported evidence of record. If the rejection statement relies upon a reference not cited in this portion of the rejection statement, Applicant respectfully requests that the reference be positively identified in a subsequent Official communication and Applicant given the opportunity to respond.

weight of the composition." Thus, the rejection statement must be implicitly asserting that Bilimoria inherently discloses such subject matter when it asserts that "the evidence of record suggests that such clays naturally include less than about 1.0% alkali and alkaline earth metals." Id. at 3-4. Applicant respectfully disagrees with the implicit inherency assertion and traverses the claim rejection.

Applicant respectfully submits that the rejection statement's implicit inherency assertion itself is evidence that Bilimoria's disclosure does not fall within the M.P.E.P.'s strict guidelines regarding what constitutes inherent disclosure. The M.P.E.P. advises that "[i]nherency may not be established by probabilities or possibilities." § 2112(IV) (citation omitted). Thus, when the rejection statement asserts that "[a]s there is no recitation of removing alkali and alkaline earth from the Rio Capim clays, the evidence of record suggests that such clays naturally include less than about 1.0% alkali and alkaline earth metals," the rejection statement is failing to show how Bilimoria discloses a kaolin having a purported alkali and alkaline earth metal content that must *necessarily* fall within the range recited in Applicant's independent claims 1 and 41.

For at least this reason, the rejection statement fails to show how Bilimoria inherently discloses a kaolin having "a total of alkali and alkaline earth metals present in the composition . . . less than or equal to about 1.0% by weight, relative to the total weight of the composition." Further, Slepetys fails to disclose the subject matter not supplied by Bilimoria. See Office Action at 3.

In view of the rejection statement's mischaracterization of Bilimoria, the rejection statement has (1) failed to properly determine the scope and contents of the prior art, (2) failed to properly ascertain the differences between the prior art and the

compositions recited in Applicant's claims 1 and 41, and (3) failed to properly articulate why the differences between the teachings of the prior art and claims 1 and 41 would have been obvious to a person having ordinary skill in the art. Thus, Applicant respectfully submits that the rejection statement has not established of *prima facie* case of obviousness.

For at least the above-outlined reasons, the rejection statement has failed to clearly articulate a reason why claims 1 and 41 would have been obvious to one of ordinary skill in the art in view of the prior art. Accordingly, a *prima facie* case of obviousness has not been established with respect to claims 1 and 41, as well as claims 2-12, 17, and 20, which depend from claim 1, and the rejection under 35 U.S.C. § 103(a) should be withdrawn.

#### **B. Rejection of Independent Claim 37**

Claim 37 was rejected under 35 U.S.C. § 103(a) based on Slepetys in view of Bilimoria. Although Applicant disagrees with the claim rejection, Applicant has amended independent claim 37 in the interest of promoting progress of the prosecution of the present application. Applicant respectfully submits that Slepetys and Bilimoria, regardless of whether they are viewed individually or as a whole, fail to disclose or render *prima facie* obvious all of the subject matter recited in amended independent claim 37. Therefore, Applicant respectfully requests the reconsideration and withdrawal of the rejection of independent claim 37, as well as claim 38, which depends from claim 37, under § 103(a) based on the rejection statement's hypothetical combination of Slepetys and Bilimoria.

Amended claim 37 is directed to a composition including, *inter alia*, “a fully calcined kaolin . . . .” The rejection statement does not assert that either Slepetys or Bilimoria disclose or render obvious “a fully calcined kaolin.” Indeed, Slepetys and Bilimoria fail to disclose or render obvious at least this subject matter recited in amended independent claim 37.

More specifically, the teachings of Slepetys are directed to the metakaolin form of kaolin. For example, Slepetys discloses that its “invention relates to novel metakaolin pigments . . . .” Slepetys at Abstract. Moreover, not only does Slepetys promote metakaolin, it teaches away from calcining the feed kaolin to achieve calcination beyond the metakaolin state. As taught by Slepetys, “[t]he kaolin exotherm must be avoided when preparing the preferred metakaolin pigments of the present invention because calcination beyond the metakaolin state results in pigments having higher than the desired abrasion values.” Id. at col. 8, ll. 13-17. As noted by the M.P.E.P., a “prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention.” § 2141.03(a). Since Slepetys teaches away from calcining kaolin beyond the metakaolin state, it would not have been obvious to one skilled in the art to have modified Slepetys in a hypothetical manner that would have resulted in “a fully calcined kaolin,” as recited in Applicant’s amended independent claim 37.

For at least the above-outlined reasons, Applicant respectfully requests reconsideration and withdrawal of the rejection of claims 1-12, 17, 20, 37, 38, and 41 under 35 U.S.C. § 103(a) based on Slepetys in view of Bilimoria.



#### IV. Conclusion

For at least the reasons set forth above, independent claims 1, 37, 41, and 44 should be allowable. Dependent claims 2-12, 17, 20, 38, and 45 depend from one of allowable independent claims 1, 37, and 44. Consequently, those dependent claims should be allowable for at least the same reasons as independent claims 1, 37, and 44. Further, withdrawn claims 13-16, 18, 19, 21, and 22 depend from allowable independent claim 1. Thus, those withdrawn claims should also be allowable.

Applicant respectfully requests reconsideration of this application, withdrawal of the claim rejections, rejoinder and examination of withdrawn claims 13-16, 18, 19, 21, and 22, and allowance of claims 1-22, 37, 38, 41, 44, and 45.

If the Examiner believes that a telephone conversation might advance prosecution, the Examiner is cordially invited to call Applicant's undersigned attorney at (404) 653-6559.

Please grant any extensions of time required to enter this Response and charge any additional required fees to Deposit Account 06-0916.

Respectfully submitted,

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